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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/947,668 | 10/09/1997 | TRACEY C. SLEMKER | 534128-002-C | 6180 |

8698 7590 02/19/2004

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| EXAMINER |
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WILLSE, DAVID H

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| ART UNIT | PAPER NUMBER |
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3738

DATE MAILED: 02/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/947,668

Applicant(s)

SLEMKER, TRACEY C.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-48, 50-55 and 64-83 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 64-78 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 81 and 82 is/are allowed.
- 6) ☒ Claim(s) 44-48, 50-55, 79, 80 and 83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 44-48, 50-55, and 83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Nowhere does the original disclosure characterize the sleeve as being “non-porous” (e.g., amended claim 44, line 3). Although the specification states that “[t]he silicone sleeve helps protect the limb and provides a seal between the limb and the socket when the limb is tightly fitted in the socket” (US 5,702,489: column 5, lines 55-58), such is certainly true of some *porous* sleeves, as seen from Fishman et al., US 5,007,937, for example. The very last limitation in claims 44, 50, and 83 is also inaccurate because there are large air pockets in chambers **20** and **34**, both of which are within the socket **12** (US 5,702,489: Figure 1; column 4, lines 15-18 and 30-34); said limitation is not the equivalent of that set forth in the original disclosure (US 5,702,489: column 6, lines 12-13).

The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claim limitations (MPEP 714.02). Because of the procedure outlined in MPEP 2163.06 for interpreting the claims, it is noted that prior art may be applicable under 35 U.S.C. 102 or 35 U.S.C. 103(a) once the aforementioned problems under 35 U.S.C. 112, first paragraph, are corrected.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 79 and 80 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Toles, US 980,457 which discloses a prosthetic limb socket **12** and **16**; a prosthetic limb assembly **2** and **20**; a base **18** including channels **19'** and a central duct; an attachment mechanism **21-24** facilitating releasable attachment of the prosthetic limb assembly to an exterior distal end of the prosthetic limb socket (page 2, lines 3-18); and a valve **15**. (The socket distal end is *capable* of being released from the prosthetic limb assembly by threadedly disengaging the nut **22** from the screw **20**.) Regarding claim 80, there are annular projections at either end of the base **18** (Figure 1; page 1, lines 105-106; etc.).

Claims 81-82 are allowed.

The Applicant's remarks have been considered. The Applicant argues that in the Toles device, "it is unlikely that it would be possible to provide a seal between the deformable sack (12) and the tube (18)" (Paper No. 26: page 22, lines 8-10). In the examiner's opinion, a seal must be inherent since otherwise a partial vacuum would not be formed in the sack (page 1, lines 80-81 and 101-104; page 2, lines 62-67; etc.). As for the limitations pertaining to the exterior distal end of the socket, the Applicant ignores how the grounds of rejection associates elements in the Toles invention with the socket as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general

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nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read 'Dave Willse', is positioned above the printed name.

Dave Willse
Primary Examiner
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